

Remarks

Applicant has amended claim 1; cancelled claim 36; and added new claim 37. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. Entry of the amendment and favorable consideration thereof is earnestly requested.

Drawing Objections

In response to the Examiner objections to the drawings in view of claims 1 and 36, Applicant has amended claim 1 to recite: "a first set of first and second link members each adapted for limited movement one with respect to the other; a resilient elastomer disposed between said first set of first and second members; a second set of third and fourth link members each adapted for limited movement one with respect to the other; a resilient elastomer disposed between said second set of third and fourth members, where the second member abuts the third member." Applicant has further cancelled claim 36.

Accordingly, Applicant respectfully submits that the drawings show every feature of the invention specified in the claims.

Claim Rejections

The Examiner has rejected the claims 1, 2, 4-10, 12-13, 15, 17-26, 28-33 and 36 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 3,266,059 (Stelle) in view of U.S. Patent No. 3,504,902 (Irwin et al.)

In response to Applicants previously submitted arguments the Examiner has submitted the following:

(a) The Examiner submitted that Applicant's "argument that Irwin is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned" and "[i]n this case, Irwin is pertinent to the particular problem of creating a flexible and compressive joint between linked components." (Official Action 4/16/08, p. 10)

Applicant did not argue that Irwin was nonanalogous art. Rather, Applicant argued that Irwin teaches directly away from the claim limitation that "substantially no compressive movement" is allowed by the elastomer. Irwin teaches that "the bearing faces 13 and 14 move relative to each other" and that this "movement may be . . . linear." (Col. 3, lns. 25-28)

The Examiner then states that "[u]pon combination of Stelle in view of Irwin the flexible joint would be between each link of Stelle. Stelle's robotic arm is held together by compression applied to the links by the springs. When a flexible joint member is inserted between two links that are held together by compression forces the flexible joint would also be held in a state of compression. Even though Irwin state that his flexible member can also extend does not meant it must extend and it is capable of being used in a compression environment." (Official Action 4/16/08, p. 10)

Applicant notes that the Examiner is selecting the flexible joint member of Irwin for combination with Stelle. Applicant highlighted how the flexible joint member of Irwin specifically allows for linear displacement (Col. 3, lns. 25-28); and defines linear movement as "the result of moving the two faces directly away from or towards each other." (Col. 3, lins. 30-32) The Examiner appears to be taking the position that even though Irwin teaches that flexible joint member allows for linear movement in connection with the system taught in Irwin, the flexible joint could be maintained under compression such that "substantially no compressive movement" is allowed in the arm of Stelle. However, the Examiner has not cited any location where teaching can be found. In fact,

a fair reading of Irwin teaches one that the flexible joint should allow for linear displacement as cited above.

It is the Examiner's burden to establish prima facie obviousness. See *In re Rijk-aert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, we find that the Examiner has not identified all the elements of claims 1 and 37, nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention. In fact, the examiner has failed to provide any evidence what-so-ever supporting the conclusion that it would be "obvious" to import the flexible joint in Irwin into Stelle and use it in a manner not taught in the prior art. Nor has the Examiner provided any evidence that as to why the teachings of Irwin relating to the flexible joint to be imported into the arm taught in Stelle should be ignored in favor of the configuration in the pending claims.

Accordingly, Applicant submits that the rejection of claims 1 and 37 over the combination of Stelle and Irwin is inappropriate.

(b) The Examiner also submitted that "applicant's argument that a 'relatively thick stabilizing ring' would render Stelle in view of Irwin a non-functioning product (page 10), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art" and that "[i]n this case, Irwin would indeed suggest to one of ordinary skill in the art that an elastomer/flexible joint can be placed in between two mov-

ing components. The size of the elastomer is dependent on the environment in which it is used." (Official Action 4/16/08, pp. 10-11)

It appears that the Examiner is reading Applicants arguments to be that it is the size of the elasomeric bearing that would prevent functioning in the robotic arm of Stelle. This is incorrect. Applicant understands that the relatively large size of the elastomeric bearing could be altered, rather, it is the construction of the bearings themselves as taught in Irwin that would prevent the use suggested by the Examiner. For example, Irwin teaches that "the bearing 15" includes a "stabilizing ring 20 . . . bonded in the bearing stack 15" and that the "stabilizing ring 20 . . . is made of a nonelastomeric substance such as metal, plastic or the like." (Col. 3, Ins. 63-68) In fact, with regard to this nonelastomeric ring, Irwin teaches that "[m]ore than one such ring can be provided."

Accordingly, even if one were to reduce the size of the bearing taught in Irwin as suggested by the Examiner, the reduced size bearing would not result in a functioning device. For example, what would result would be reduced size bearing that comprises layers of elastomer bonded together and a nonelastomeric stabilizing ring positioned therein comprising metal, plastic or the like. The Examiner has presented no evidence as to how the bearing constructed as taught in Irwin could function as per claims 1 and 37. The Examiner has also failed to present any evidence as to why one would remove nonelastomeric stabilizing ring from the bearing stack when this is identified as a key feature to maintain stability of the bearing. (*Id.*)

Accordingly, Applicant submits that the rejection of claims 1 and 37 over the combination of Stelle and Irwin is inappropriate.

With regard to the Examiner's remaining comments relating to KSR (at 8.), Applicant notes that the Examiner appears to be taking the position that the combination of Stelle with Irwin would function despite Applicants numerous citations to the art of record and accompanying reasoning as to why the system would be non-functional.

However, the Examiner has provided no evidence refuting the evidence supporting Applicant's arguments.

With regard to the Examiner's remaining comments relating to the elastomer crushing the springs (at 9.), Applicant is simply stating that the elastomer taught in Irwin is a ring that extends around the circumference of the device in Irwin and completely isolates the bearing faces 11 and 12 from each other. If one were to take the elastomer taught in Irwin and incorporate it into the arm of Stelle, the elastomer would be positioned in the place of the springs. Additionally, the Examiner has provided no evidence as to why one would alter the configuration of the bearing taught in Irwin to somehow accommodate the spring configuration in Stelle.

It is respectfully requested that the Examiner withdraw the rejections of the presently pending claims based on a combination of Stelle with Irwin as the pending claims can not be obvious in view of this suggested combination. Claims 1-2, 4, 6-10, 12-13, 15, 17-26, 28-33 and 37, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

June 5, 2008

/Wesley W. Whitmyer, Jr./
Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicants
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
Tel. 203 324-6155